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July 30, 2003

VIA EXPRESS MAIL

Clerk
Board of Patent Appeals and Interferences
P.O. Box 1450
Alexandria, Va. 22313

Re: Recent Case of the Federal Circuit Pertinent to:
Appeal No. 2003-0068
Orally Argued: June 10, 2003
Application No. 09/415,696
Applicant: WRIGHT et al.
Primary Examiner: Jes F. Pascua
Title: RECLOSABLE FASTENER PROFILE SEAL AND METHOD OF
FORMING A FASTENER PROFILE ASSEMBLY
Filing Date: October 12, 1999
Atty. Docket No. 21276.00.9044

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AND INTERFERENCES

To the Clerk of the Board of Patent Appeals and Interferences:

The Applicant in Appeal No. 2003-0068 wishes to bring to the Board's attention, case law of the Federal Circuit¹ rendered since the above-identified Appeal was briefed and which bears directly on the Appeal.

In *Texas Digital Systems. v. Telegenix, Inc.*, 308 F.3d 1193 (Fed. Cir. 2002), the Court held that claim terms are to be given their ordinary meanings and that ordinary meanings of claim terms can be obtained from dictionaries, encyclopedias and treatises.² With regard to the use of dictionaries to construe claims, the Court said:

"Because words often have multiple dictionary definitions, some having no relation to the claimed invention, the intrinsic record must always be consulted to identify which of the different possible dictionary meanings of the claim terms in issue is most consistent with the use of the words by the inventor."³

¹ *Texas Digital Systems. v. Telegenix, Inc.*, 308 F.3d 1193 (Fed. Cir. 2002);

² 308 F.3d at 1202

³ *Id.*

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In cases rendered since *Texas Digital Systems*, the Court has consistently said that the context in which a claim term is used should *always* be considered when a dictionary provides multiple definitions for a claim term. See e.g., *Intellectual Property Development, Inc. v. UA-Columbia Cablevision of Westchester, Inc.*, 2003 U.S. App. LEXIS 14586 (Fed. Cir., 2003) ([T]he dictionary definition that is most consistent with the specification and prosecution history is the definition that defines "high frequency" as including frequencies in the range of 3-30 MHz."); *Brookhill-Wilk 1 LLC v. Intuitive Surgical, Inc.*, 2003 U.S. App. LEXIS 13861, 67 U.S.P.Q. 2d 1132 (Fed. Cir. 2003)([P]recedent referencing the use of dictionaries should not be read to suggest that abstract dictionary definitions are alone determinative. In construing claim terms, the general meanings gleaned from reference sources such as dictionaries, must always be compared against the use of the terms in context, and the intrinsic record must always be consulted to identify which of the different possible dictionary meanings is most consistent with the use of the words by the inventor.)

In the Examiner's Answer in the above-identified Appeal, the Examiner cited a dictionary definition of "seal." Contrary to the holdings of *Texas Digital Systems* and its progeny, the Examiner cited the definition that best suited his rejection, i.e., the one definition of many definitions that included the word "airtight" in the definition. The Examiner should not have selected a definition that best supported the rejection but should have selected the dictionary definition that best conformed the context in which it was used in the prior art references.

As can be seen below, the Merriam Webster's Collegiate Dictionary, Tenth Edition, copyright 1997 provides several definitions for the noun "seal."

seal *n* [ME *seel*, fr. OF, fr. L *sigillum* seal, fr. dim. of *signum* sign, *seal* — more at SIGN] (13c) **1** **a** : something that confirms, ratifies, or makes secure : GUARANTEE, ASSURANCE **b** (1) : a device with a cut or raised emblem, symbol, or word used esp. to certify a signature or authenticate a document (2) : a medallion or ring face bearing such a device incised so that it can be impressed on wax or moist clay; also a piece of wax or a wafer bearing such an impression **c** : an impression, device, or mark given the effect of a common-law seal by statute law or by American local custom recognized by judicial decision **d** : a usually ornamental adhesive stamp that may be used to close a letter or package; esp. : one given in a fund-raising campaign **2** **a** : something that secures (as a wax seal on a document) **b** : a closure that must be broken to be opened and that thus reveals tampering **c** (1) : a tight and perfect closure (as against the passage of gas or water) (2) : a device to prevent the passage or return of gas or air into a pipe or container **3** : a seal that is a symbol or mark of office — **under seal** : with an authenticating seal affixed

Definitions for the noun "seal" provided by Webster's Dictionary.

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As argued by the Applicants in their briefs, the prior art cited by the Examiner does not show an "airtight seal." The art cited by the Examiner teaches "seals" but does not teach an "airtight seal."

Under *Texas Digital Systems* and its progeny, it was improper for the Examiner to select one definition of many, according to how well it supported his rejection. He should have considered the context in which "seal" was used in the prior art references.

Under *Texas Digital Systems* and its progeny, it was improper for the Examiner to cite to the Board, a dictionary definition of "seal" as ostensibly teaching the claim limitation, without regard to the context in which the claim term "seal" was used in the prior art patents where the term "seal" was found.

In the pending claims, "airtight" is an adjective that modifies the word "seal." Construing the word "seal" to mean "airtight" as the Examiner argues, contradicts the context in which the "airtight seal" limitation is used in the pending specification and claims. In effect, the Examiner's construction of the word "seal" means that the applicants are claiming an "airtight-airtight seal." The Examiner's interpretation of "seal" makes the "airtight" adjective in the pending claims, redundant and meaningless, which is contrary to the teachings of *Texas Digital Systems, Inc.*

Under *Texas Digital Systems* and its progeny, the Examiner should have considered how the "airtight" claim limitation modifies the word "seal" and considered the allowability of the claims using the Merriam Webster's dictionary definition of "airtight" that best conforms to the context in which it is used in the pending application.

air-tight \ 'ar-,tīt, 'er-\ *adj* (1760) 1 : impermeable to air or nearly so
2 : **a** : having no noticeable weakness, flaw, or loophole (an ~ argument) **b** : permitting no opportunity for an opponent to score (an ~ defense) — **air-tight-ness** *n*

Merriam Webster's Collegiate Dictionary, Tenth Edition definitions of "airtight."

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Accordingly, we believe that the prior art references do not teach, suggest or imply an "airtight seal", whether taken singly or in combination, nor is an "airtight seal" inherent in the references cited.

Copies of the foregoing decisions are attached for your convenience.

Respectfully submitted,

By: Robert S. Beiser
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Date: July 30, 2003

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cc: Examiner Jes F. Pascua (via Express Mail with enclosures)